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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,295	08/21/2003	Yasuhiro Mori	051319/0055	7197
29619	7590	04/07/2006	EXAMINER	
SCHULTE ROTH & ZABEL LLP			COMPTON, ERIC B	
ATTN: JOEL E. LUTZKER			ART UNIT	
919 THIRD AVENUE			PAPER NUMBER	
NEW YORK, NY 10022			3726	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,295

Applicant(s)

MORI, YASUHIRO

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-8 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3,5,6 and 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Section [0009], line 1, "The pivot" should read --the pivot.--.

Appropriate correction is required.

Claim Objections

2. Claims 3 and 6 are objected to because of the following informalities: in line 6, before "pressure" there should be --applying--or similar verb. Appropriate correction is required.
3. Claims 5 and 8 are objected to because of the following informalities: in line 3, "a welding means" should read just --welding--, since means-plus-function language does not make sense in a method claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

5. At least Claim 1 is rejected under 35 U.S.C. 102(f) because it appears that applicant did not (solely) invent the claimed subject matter. U.S. Pat. Pubs. 2004/0131292 & 2004/0120079, to Koyama and Tsuchiya, respectively disclose

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essentially the same invention as claim 1. However, the inventor of the instant invention Mori is different from the inventors of those references. It is noted that all three have a common assignee of MINEBEA CO., LTD.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, recites, "An apparatus for a pivot assembly, comprising ..." a bearing assembly and a seal member. See Figure 1 (showing pivot assembly).

Claim 2, which depends from claims 2, recites structure for an assembly apparatus, e.g. means for supporting bearing assembly; means for imparting pressure to the seal member; and means for welding the seal member. See Figure 5 (showing pressing piece 7 and pad). The limitations of claim 2 are not part of the completed pivot assembly.

It seems that claim 2 is drawn to a different apparatus, namely an assembly apparatus for forming a pivot assembly, while claim 1, is drawn to a pivot assembly. Therefore, the preamble of claim 1, "An apparatus for a pivot assembly ..." is ambiguous, since it is not clear if Applicant means the pivot assembly only as shown in

Figure 1, the assembly apparatus only, or the combination of the two as shown in Figure 5.

Allowable Subject Matter

8. Claims 3-8 are allowed.
9. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a method of manufacturing a pivot assembly comprising: imparting a pre-load to pressure to the inner ring by applying pressure on the seal member; and fixing the seal member to an outer circumference of the shaft, in combination with the other claimed subject matter.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. 5,529,404 discloses a similar invention, but does not disclose welding the pressing the seal to preload the bearings and then welding the seal.

U.S. Pat. 5,882,122 discloses a similar invention, see Figure 6; Col. 24, lines 3-32, where bushes 29 are welded into place to preload bearings. Figures 8-9 show an alternate embodiment in where the bushes are replaced by "pressure member 32." See

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Col. 25, lines 45-59. However, the reference is unclear as to where the pressure member 32 is a seal. Note: U.S. Pat. 6,513,983 (same inventors and assignee), Col. 3, line 63 – Col. 4, line 10 (refers to same similar structure as "labyrinth seal," but is silent as to the assembly method, especially preloading).

JP 06-026525 suggests a similar invention for a wheel bearing.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on (571) 272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton
Primary Examiner
Art Unit 3726